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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/817,609	04/02/2004	Michael W. Pfeiffer	STL11386	2452
7590 02/02/2007 Fellers, Snider, Blankenship, Bailey & Tippens, P.C. Suite 1700 100 North Broadway Oklahoma City, OK 73102-8820			EXAMINER NGUYEN, TAI V	
			ART UNIT 3729	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	DELIVERY MODE
3 MONTHS			02/02/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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Office Action Summary

Application No.

10/817,609

Applicant(s)

PFEIFFER ET AL.

Examiner

Tai Van Nguyen

Art Unit

3729

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-13 and 15-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,9,11-13 and 15-17 is/are rejected.
- 7) ☒ Claim(s) 4,6,7,10 and 18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. The applicants' amendment filed 11/15/2006 has been fully considered and made of record.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2, 2, 9, 11, 12 and 15-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Budde (US 5,575,586).

As applied to claims 1,2, 9 and 12, Budde discloses an apparatus comprising a carrier (e.g. 18, Fig. 7) adapted to protect a head stack assembly comprising a cantilevered flexure (e.g. 16) which supports a transducer attached to sliders at a distal end thereof, the carrier comprising a carrier support surface arranged to continuously, contactingly support the distal end of the flexure adjacent the transducer and to permit a subsequent engagement of a medial portion of the flexure by a merge tool (e.g. 100, 102) which disengages the flexure from the carrier support surface (1 16A-1 16B) while merging the transducer with a recording surface.

As applied to claim 3, Budde discloses the carrier further comprises a retention feature (18a) which engage an edge of the head stack assembly to retain the carrier on the head stack assembly.

As applied to claim 5, Budde discloses the carrier in combination with the merge tool (column 5, lines 33-60+).

As applied to claim 11, Budde discloses the merge tool in combination with the carrier (see Fig. 7).

As applied to claim 13, Budde discloses the carrier further comprises a retention feature which engages an edge of the head assembly (e.g. 14) to retain the carrier on the head stack assembly (see Fig. 7).

As applied to claim 15 Budde discloses an apparatus, comprising: a carrier adapted (e.g. 18) to protect a head stack assembly comprising a cantilevered flexure (e.g. 16) which supports a transducer (e.g. 14) at a distal end thereof, the carrier comprising a carrier support surface arranged to contactingly support the distal end of the flexure by continuous deflection of the distal end; and a merge tool (e.g. 100, 102) adapted to merge the transducer with a recording surface (e.g. 8) comprising a merge support surface arranged to contactingly support a medial portion of the flexure while the carrier support (e.g. 18) surface is disposed between the merge support surface and the transducer (e.g. 14).

As applied to claim 16, Budde discloses wherein the carrier (A< Fig. 7) further comprises an elongated body having a medial portion that extends adjacent the medial

portion of the flexure (16) and a distal end which support the carrier support surface (see Fig. 7).

As applied to claim 17, Budde discloses wherein the carrier further comprises a retention feature which engages an edge of the head stack assembly to retain the carrier on the head stack (e.g. 14) assembly.

Note: see Examiner's Attachment.

Allowable Subject Matter

4. Claims 4, 6, 7, 10 and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

5. Applicant's arguments filed 11/15/2006 have been fully considered but they are not persuasive.

In regards the merits of Budde, the applicants contends that Budde do not teach: 1) "contactingly support the distal end of the flexure adjacent the transducer" (as recited of claim1, line 4); 2) "subsequent engagement of a medial portion of the flexure by a merge tool which disengages the flexure from the carrier support surface while merging the transducer with a recording surface" (as recited of claim 1, lines 5-7).

The examiner most respectfully disagrees for the following reasons:

1) In Budde, the claimed "carrier" was read as arm 18, which has a carrier support surface arranged to continuously, cantactingly support the distal end of the flexure adjacent the transducer (e.g. 14). The claimed "distal end" can be read as any end of the flexure that is adjacent the transducer, including the proximal end adjacent the transducer.

The examiner notes that the applicant(s) appear to be relying on the function or operation of the tool and not the structure. Patentability of an apparatus, i.e. tool, hinges on the structure and not the function, or manner of operation of the apparatus.

While features of an apparatus may be recited either structurally or functionally, claims<directed to >an< apparatus must be distinguished from the prior art in terms of structure rather than function. >In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429,1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); < In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch &Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original).

2) In Budde, the tool 100 was read as the claimed "merge tool". The tool 100 of Budde is certainly capable of performing the function of "while merging the transducer with a recording surface" because: 1) there is no structural distinction between the

merge tool as claimed and 2) the tool 100 of Budde is used within the disc drive, and include the recording surface, e.g. disc.

Therefore, the examiner's position is the claims do not distinguish structurally over Budde.

Conclusion

6. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tai Van Nguyen whose telephone number is 571-272-4567. The examiner can normally be reached on M-F (7:30 A.M - 4:30 P.M).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3729

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TN. January 23, 2007



A. DEXTER TUGBANG
PRIMARY EXAMINER